DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on March 24, 2006 is hereby acknowledged, Claims 1-5 and 10-26 remain pending.

2. The application was remanded by the USPTO Board of Patent Appeal and Interferences on November 29, 2007 ("2007 Remand").

3. In view of the 2007 Remand, PROSECUTION IS HEREBY REOPENED. As set forth below.

4. The Examiner notes that claim 26 was not addressed in prior Office Actions. As noted in the 2007 Remand, this office action is to address claim 26.

5. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 C.F.R. §1.111; or,

(2) initiate a new appeal by filing a notice of appeal under 37 C.F.R. §41.31 followed by an appeal brief under 37 C.F.R. §41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 C.F.R. §41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

6. A Supervisory Patent Examiner ("SPE") has approved of reopening prosecution by signing below.

Claim Rejections - 35 USC §112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. §112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 26 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no support in the original disclosure for the claimed feature of "the program module is larger than the licensing module."

Claim Rejections - 35 USC §112 2nd Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 26 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, it is unclear what metric the term "larger" refers to. The term could mean larger in source code, executable code, or simply require larger memory to run. Because one of ordinary skill in the art can not reasonably ascertain whether or not one module is larger that the other (since it depends upon what aspects the comparison is made in reference to), the claim is indefinite.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 10-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Biddle et al (U.S. Patent Application Pub. No. 2002/0107809 A1).

13. As per claim 10, Biddle et al teach an improved system for software distribution (*improved distribution system, 20)* over wide area computer networks (*internet, 35)*, the networks comprising a network conduit (*data links 45, 50 and 55)*, at least one e-commerce server computer (*distributor 25, vendor 40)* in communication (*interconnected)* with the network conduit, at least one customer terminal computer (*user computer, 30)* in communication with the network conduit, and at least one supplier server computer (*distributor 25, vendor 40)* in communication (*interconnected)* with the network conduit, each the computer comprising at least one programmable computer comprising input means, display means, processing means, storage means and means for communicating with the network conduit *(see abstract figs 1, 2, page 2, paragraphs 0013, 0015, and 0016, page 4 paragraph 0049, 0050)*, the system comprising e-commerce site means (*licensing server, 82)* for distributing licensing modules (*licensing)* to each the customer terminal computer via the network conduit; and program download site means

(*distributor 25, vendor 40)* for distributing program modules (*software)* to each the customer terminal computer via the network conduit (*see fig 1, page 5, paragraph 0053, 0054, 055).*

14. As per claim 11, Biddle et al teach an improved system wherein the e-commerce site means comprises an executable software application being executed on the e-commerce server computer (*see fig 1, page 5, paragraph 0053, 0054).*

15. As per claim 12, Biddle et al teach an improved system wherein the program download site means comprises an executable software application being executed on the supplier server computer (*see fig 1, page 5, paragraph 0053, 0054).*

16. As per claim 13, Biddle et al teach an improved system wherein the licensing modules and the program modules each comprise executable software applications for execution on programmable computers, each the licensing module cooperating with one the program module to function as a whole software application (*see fig 1, page 5, paragraph 0054, 0055).*

17. As per claim 14, Biddle et al teach an improved system wherein each the distribution of one the program module is responsive to the prior execution of one the licensing module on one the customer terminal computer (*see fig 1, page 5, paragraph 0053, 0054).*

18. As per claim 15, Biddle et al teach an improved system wherein each the distribution of one the program module commences automatically in response to user input to the executed

licensing module through the input means of the customer terminal computer (*see fig 1, page 5, paragraph 0053, 0054)*.

19. As per claim 16, Biddle et al teach an improved system wherein the execution of the program module defines a licensed condition and an unlicensed condition, the program module executes in the licensed or unlicensed condition responsive to output from the licensing module (*fig 2, page 6 paragraph 0057)*.

20. As per claim 17, Biddle et al teach an improved system wherein execution of the program module in the unlicensed condition is permitted for a pre-defined period of time, whereby expiration of the pre-defined period of time will prevent the program module from further execution (*see fig 9 and 10, page 6 paragraph 0059)*.

21. As per claims 18, Biddle et at teach a method of distribution (*distribution system)* a software product to user (*user, 30)* over a computer network (*see fig 1)* comprising configuring the software product as a program module and a licensing module wherein both the program and the licensing module are required in order to operate the software product (*see paragraphs 0055)*, the licensing software comprising a portion of the software product that is customized for a distributor or a group of distributors and the program module comprising a portion of the software product that is not customized for a specific distributors, configuring the licensing module to the requirement of a distributor, storing the configured licensing module at the distributor's software distribution point so that it may be downloaded by a user and storing the

program module at a location other than the distributor's software distribution point (*see paragraphs 0055, 0058, 0059, 0062, 0065, 0066, 0062)*

22. As per claim 19-21 Biddle teach a method wherein subsequent to downloading the licensing module and is certain predetermine conditions such as payment, user registration are met the user may download the program module (*see paragraphs 0100.*

23. As per claim 22, Biddle teach a method further comprising updating the software product bi modifying the program but not modifying the licensing module (*see paragraph 0078, 0087).*

24. As per claim 23-26, Biddle teach a method running the licensing module within a predetermined period of time to automatically download the program module (*see paragraphs 0100)*

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

26. Claims 1-5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et al (U.S. Patent Application Pub. No. 2002/0107809 A1) in view of Hayes et al (U.S. PG Pub No. 2001/0011341).

27. As per claim 1, Biddle teaches an improved system (*improved distribution system, 20)* for electronic data (*software)* sales and distribution (*distribution)* over wide area computer networks (*internet, 35) (see abstract figs 1, 2, page 2, paragraphs 0013, 0015, and 0016, page 4 paragraph 0049)*, the networks comprising a network conduit (*data links 45, 50 and 55)*, at least one e-commerce server computer (*distributor 25, vendor 40)* in communication (*interconnected)* with the network conduit (*see fig 1, page 4, paragraph 0049),* , and at least one customer terminal computer (*user computer, 30)* in communication (*interconnected)* with the network conduit, each the computer comprising input means, display means, processing means, storage means and means for communicating with the network conduit (*see page 4 paragraph 0050)*, the system comprising e-commerce site means (*distributor 25, vendor 40)* for presenting e-commerce functions (*online transactions enabling purchase)* to each the customer in communication with the e-commerce server computer via the network conduit (*see fig 1, page 5, paragraph 0053, 0054)* (*see fig 17, page 5 paragraph 0054, 0055, page 6 paragraph 0056, 0057, 0058)* and program download site means (*distributor 25, vendor, 40)* for providing a program module (*software application)* for downloading (*downloading)* to each the customer terminal computer responsive to a user request (*see fig 1, page 5, paragraph 0054 (bottom)*.

28. Biddle fails to teach a licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system.

29. However, Hayes teaches licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system (*see paragraph 0013).*

30. Therefore, it would have bee obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Biddle to include Hayes et al's inventive concept of a licensing module means for giving each the customer terminal computer permission to download a program module to the customer terminal computer the licensing module means comprising an executable software application being executed on each the customer terminal computer engaged in the improved system because this would have ensure greater security of the system.

31. As per claim 2, Biddle et al teach an improved system wherein the e-commerce site means comprises an executable software application being executed by the processing means of the e-commerce server computer and the program download site means comprises an executable software application being executed by a processing means in a program module server computer, the e-commerce server computer and the program module server computer being distinct from one another (*see fig 1, page 5, paragraph 0053, 0054).*

32. As per claim 3, Biddle et al teach an improved system wherein the e-commerce site means further provides each the customer terminal computer with the ability to download the licensing module means (*see fig 1, page 5, paragraph 0053, 0054).*

33. As per claim 4, Biddle et al teach an improved system further comprising a supplier terminal computer (*distributor 25)* in local area network communication with the program module server computer (*see fig 1, page 5, paragraph 0053, 0054)*.

34. As per claim 5, Biddle et al teach an improved system wherein the functionality of the program module is responsive to output from the licensing module, the program module and the licensing module each comprising executable software applications, wherein output from the licensing module is input to the program module when the program module and the licensing module are executed on the processing means of a single computer (*see fig 1, page 6, paragraph 0056, 0057)*.

35. As per claim 26, Biddle discloses as discussed above. Official Notice is taken that "wherein the program module is larger than the licensing module" is common knowledge and/or old and well known in prior art in reference to software design because software modules are almost always of various size. It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made that the program module would be larger than the license module in order to allow efficient usage of system memory.

Response to Arguments

36. Applicant's arguments filed December 6th, 2004 have been fully considered but they are not persuasive.

37. Applicant argues it appears that (BIDDLE et al) discloses adding the software application to the electronic store to allow users to download the software application to a user computer. After downloading and installing the application, user has the option of obtaining a license for the application. Thus, it appears that Biddle first downloads the program module (software) and then a license module. Applicant further argues that in claim 10 of the disclosure recites the distribution of one the program module is responsive to the prior execution of said licensing module on one the customer terminal computer. According to the Applicant's argument the downloading of the identified elements of Biddle is in the opposite order to that recited in claim 10. Examiner respectfully disagrees with Applicant's characterization of the prior art. Biddle et al teach that software application are added to an electronic store by the distributor, the user may then download the application to the user computer. The user then begins the process by engaging a browsing session and select a software application from a displayed list of applications. User then selects the software application to be downloaded by using a mouse, or any other input device to be downloaded. The distributor computer then suitably downloads the selected software application as an executable file to the user computer. Another software module, referred to as a license manager, may also be downloaded to the user computer. It may appear that in Biddle disclosure that the licensing module is downloaded after the application has

been downloaded in the user computer. However, also disclose that the programming module is responsive prior to the execution of the licensing module which indicate that the licensing module is executed after a response from the program.

38. Applicant further argues that Hayes fail to teach an inventive concept with a licensing module according to claims 1. Examiner respectfully disagrees with applicant characterization of the prior art. Hayes teach in paragraph 0013 that the server stores a plurality of user applications for downloading to user stations and further stores access permissions for the applications for each user. When a user attempts to log onto the system from a user station, the server receives a user log-on identifier from the user. The server uses the identifier to build a list of applications for which the user has access permission. A desktop object is then downloaded to the user station to control the interface between the user and the user's station. The server also downloads to the station a list of applications to which the user has access permission. The user station uses the list to build a folder containing only the applications from the list to which the user has access permission. The system further verifies that the user has access to applications that are represented by icons that the user may have added to his or her desktop at an earlier time. For each user desktop preference specified by the user at an earlier time that corresponds to a user application, the access permission for the user to the user application is checked from the list, and, if the application is not included on the list, the desktop object representing the application is removed from the desktop. Hayes in fact does not use the word license module. However one or ordinary skill in that art would recognize that having access permission to download and having license to execute a program have the same technological meaning

Conclusion

39. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The Examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

40. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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